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09/707,987	11/08/2000	John C. Myers	11559STUS02U	1024

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EXAMINER
GAUTHIER, GERALD

ART UNIT	PAPER NUMBER
2645	11

DATE MAILED: 05/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/707,987	MYERS ET AL.	
	Examiner	Art Unit	
	Gerald Gauthier	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-54 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-54 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. **Claims 1-2, 6, 8, 10, 12, 15, 17-27, 29, 32-35, 39, 41, 43, 45, 48 and 50-54** are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldfinger et al. (US 6,449,344) in view of Vardi et al. (US 6,389,127).

Regarding **claim 1**, Goldfinger discloses a communication system (column 1, lines 14-16), (which reads on claimed "a method of accessing instant messaging") comprising the step of:

presenting to a user (18 on FIG. 1) a subset of a predetermined user list (column 6, line 15 "list of sought users"), the subset representing users logged onto a data network (column 6, lines 14-24) [The information management apparatus checks the list of connected users and displays the list on the terminal];

responsive to the user selecting a particular user (34 on FIG. 1) from the subset of the predetermined user list, sending a message (column 6, line 67 "a point-to-point connection") from the telephone user to the selected data network user using an instant messaging protocol (column 6, line 66 to column 7, line 6) [The user makes a point-to-point connection using the network address of the sought user].

Goldfinger fails to disclose the user terminal is a telephone.

However, Vardi teaches the user terminal is a telephone (column 7, lines 12-19).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the telephone of Vardi in the invention of Goldfinger.

The modification of the invention would offer the capability of a telephone, as the user terminal such as the system would provide the status of the telephone line.

Regarding **claims 2 and 35**, Goldfinger discloses the step of presenting occurs upon receipt of a predetermined command from the telephone user (column 6, lines 25-34).

Regarding **claims 5, 8, 38 and 41**, Goldfinger discloses the step of presenting includes displaying names on the user list on a display associated with the telephone (column 6, lines 14-24).

Regarding **claims 6 and 39**, Goldfinger discloses the step of presenting occurs automatically upon login by the telephone user (column 5, lines 37-48).

Regarding **claims 10 and 43**, Goldfinger and Vardi as applied to **claims 1 and 34** differ from **claims 10 and 43,** in that it fails to disclose receiving a DTMF command.

However, Vardi teaches the step of selecting includes the step of receiving a DTMF command from the telephone user (column 6, lines 6-18).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use receiving a DTMF command of Vardi in the invention.

The modification of the invention would offer the capability of receiving a DTMF command such as the system would allow a real-time message exchange.

Regarding **claims 12 and 45**, Goldfinger and Vardi as applied to **claims 1 and 34** differ from **claims 12 and 45,** in that it fails to disclose receiving a proprietary signal from the telephone.

However, Vardi teaches the step of selecting includes the step of receiving a proprietary signal from the telephone (column 6, lines 1-7).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use receiving a proprietary signal from the telephone of Vardi in the invention.

The modification of the invention would offer the capability of receiving a proprietary signal from the telephone such as the system would allow a real-time message exchange.

Regarding **claims 15 and 48**, Goldfinger discloses the step of sending a message includes sending a prerecorded text message (column 6, lines 14-24).

Regarding **claims 17 and 50**, Goldfinger discloses the steps of receiving an instant message in response the message sent by the telephone user and notifying the telephone user of the receipt of the message (column 7, lines 1-6).

Regarding **claims 18 and 51**, Goldfinger discloses the step of sending a message includes the telephone user's telephone number and a duration of time the telephone user will be available at that number (column 6, lines 52-65).

Regarding **claims 19 and 52**, Goldfinger discloses the steps of, during the duration of time, receiving an instant message in response the message sent by the telephone user and notifying the telephone user of the receipt of the message at the telephone user's telephone number (column 6, lines 14-34).

Regarding **claims 20 and 53**, Goldfinger discloses the step of presenting includes the steps of first determining whether the telephone user is logged onto the data network and if not then presenting the user list (column 5, lines 37-48).

Regarding **claims 21 and 54**, Goldfinger discloses the step of determining whether the telephone user is logged onto the data network includes determining if the telephone subscriber is a personal communications subscriber and, if the user is, maintaining a presence in the data network for the telephone user for receiving and forwarding instant messages to the telephone user (column 5, lines 37-60).

Regarding **claim 22**, Goldfinger discloses a communication system (column 1, lines 14-16), (which reads on claimed "an apparatus for accessing instant messaging") comprising:

a data interface (12 on FIG. 1) for connection to a data network (14 on FIG. 1); and

a messaging module (20 on FIG. 1) for presenting a user list (column 6, line 15 "list of sought users") of active data network users to a user (18 on FIG. 1) via the interface and responsive to the user selecting a particular user (34 on FIG. 1) from the user list, sending a message (column 6, line 67 "a point-to-point connection") from the user to the selected data network user via the data interface using an instant messaging protocol (column 6, line 66 to column 7, line 6) [The user makes a point-to-point connection using the network address of the sought user].

Goldfinger fails to disclose the user terminal is a telephone.

However, Vardi teaches a telephone interface (24 on FIG. 1) for connection to a telephone network (14 on FIG. 1) and the messaging is sent from a telephone (column 7, lines 12-19).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the telephone of Vardi in the invention of Goldfinger.

The modification of the invention would offer the capability of a telephone, as the user terminal such as the system would provide the status of the telephone line.

Regarding **claim 23**, Goldfinger and Vardi as applied to **claim 22** differ from **claim 23,** in that it fails to disclose a call-back feature.

However, Vardi teaches the messaging module includes a call-back feature for notifying the telephone user when an instant messaging reply is received for the telephone user (column 1, lines 53-58).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a call-back feature of Vardi in the invention.

The modification of the invention would offer the capability of a call-back feature such as the system would allow a real-time message exchange.

Regarding **claims 24, 25, 26 and 27**, Goldfinger discloses the data network is a local area network (column 4, lines 49-59).

Regarding **claim 29**, Goldfinger discloses the messaging module is a portion of a server in the data network (column 4, lines 49-59).

Regarding **claim 32**, Goldfinger discloses the messaging module is a portion of a telephone network service (column 4, lines 49-59).

Regarding **claim 33**, Goldfinger discloses a communication system (column 1, lines 14-16), (which reads on claimed "a method of accessing instant messaging on the data network") comprising the steps of:

establishing the user's presence (column 6, line 15 "list of sought users") and ability to receive instant messages (column 6, line 67 "a point-to-point connection") on the data network during the specify time period (column 6, lines 35-51) [The annunciation to user includes the unique identification code for the sought user];

where an instant message (column 6, line 67 "a point-to-point connection") is sent to the subscriber during this period of availability and delivering the message (column 6, line 66 to column 7, line 6) [The user makes a point-to-point connection using the network address of the sought user].

Goldfinger fails to disclose identifying a telephone number and calling the subscriber.

However, Vardi teaches identifying a subscriber (10 on FIG. 1), a telephone number (column 5, line 37 "individual telephone number") at which they can receive messages at this number (column 5, lines 33-38);

calling the subscriber at the predetermined telephone number (column 7, lines 39-48).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use identifying a telephone number and calling the subscriber of Vardi in the invention of Goldfinger.

The modification of the invention would offer the capability of identifying a telephone number and calling the subscriber such as the system would provide the status of the telephone line.

Regarding **claim 34**, Goldfinger discloses a communication system (column 1, lines 14-16), (which reads on claimed "a method of accessing instant messaging on a data network") comprising the step of:

establishing the subscriber's presence (column 6, line 15 "list of sought users") and ability to receive instant messages (column 6, line 67 "a point-to-point connection") on the data network during the specified time period (column 6, lines 35-51) [The annunciation to user includes the unique identification code for the sought user];

presenting to the subscriber a subset of a predetermined user list (column 6, line 15 "list of sought users"), the subset representing users logged onto a data network (column 6, lines 14-24) [The information management apparatus checks the list of connected users and displays the list on the terminal];

responsive to the subscriber selecting a particular user (34 on FIG. 1) from the subset of the predetermined user list, sending a message (column 6, line 67 "a point-to-

point connection") from the subscriber to the selected data network user using an instant messaging protocol (column 6, line 66 to column 7, line 6) [The user makes a point-to-point connection using the network address of the sought user].

Goldfinger fails to disclose identifying a telephone user.

However, Vardi teaches identifying a telephone user (10on FIG. 1) as a subscriber, a telephone number (column 5, line 37 "individual telephone number") at which they can received messages, for which they can receive messages at this number (column 5, lines 33-38).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use identifying a telephone user of Vardi in the invention of Goldfinger.

The modification of the invention would offer the capability of identifying a telephone user such as the system would provide the status of the telephone line.

4. **Claims 3-4, 7, 9, 11, 13-14, 16, 30-31, 36-37, 40, 42, 44, 46-47 and 49** are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldfinger in view of Vardi and in further view of Sekiguchi et al. (US 5,848,134).

Regarding **claims 3, 7, 36 and 40**, Goldfinger and Vardi as applied to **claims 2, 6, 35 and 39** differ from **claims 3, 7, 36 and 40,** in that it fails to disclose voice-synthesizing names.

However, Sekiguchi teaches the step of presenting includes voice-synthesizing names on the user list (column 11, lines 23-31).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use voice-synthesizing names of Sekiguchi in the invention of Goldfinger and Vardi.

The modification of the invention would offer the capability of voice-synthesizing names such as the system would allow a real-time message exchange.

Regarding **claims 4, 9, 37 and 42**, Goldfinger and Vardi as applied to **claims 2, 6, 35 and 39** differ from **claims 4, 9, 37 and 42,** in that it fails to disclose playing back prerecorded names.

However, Sekiguchi teaches the step of presenting includes playing back prerecorded names on the user list (column 11, lines 32-39).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use playing back prerecorded names of Sekiguchi in the invention of Goldfinger and Vardi.

The modification of the invention would offer the capability of playing back prerecorded names such as the system would allow a real-time message exchange.

Regarding **claims 11 and 44**, Goldfinger and Vardi as applied to **claims 1 and 34** differ from **claims 11 and 44,** in that it fails to disclose receiving a voice command.

However, Sekiguchi teaches the step of selecting includes the step of receiving a voice command from the telephone user (column 11, lines 63-65).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use receiving a voice command of Sekiguchi in the invention of Goldfinger and Vardi.

The modification of the invention would offer the capability of receiving a voice command such as the system would allow a real-time message exchange.

Regarding **claims 13 and 46**, Goldfinger and Vardi as applied to **claims 1 and 34** differ from **claims 13 and 46,** in that it fails to disclose sending a voice message.

However, Sekiguchi teaches the step of sending a message includes recording and sending a voice message (column 11, lines 63-65).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use sending a voice message of Sekiguchi in the invention of Goldfinger and Vardi.

The modification of the invention would offer the capability of sending a voice message such as the system would allow a real-time message exchange.

Regarding **claims 14 and 47**, Goldfinger and Vardi as applied to **claims 1 and 34** differ from **claims 14 and 47,** in that it fails to disclose sending a prerecorded voice message.

However, Sekiguchi teaches the step of sending a message includes sending a prerecorded voice message (column 11, lines 63-65).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use sending a prerecorded voice message of Sekiguchi in the invention of Goldfinger and Vardi.

The modification of the invention would offer the capability of sending a prerecorded voice message such as the system would allow a real-time message exchange.

Regarding **claims 16 and 49**, Goldfinger and Vardi as applied to **claims 1 and 34** differ from **claims 16 and 49,** in that it fails to disclose sending a text transcription of a voice message.

However, Sekiguchi teaches the step of sending a message includes sending a text transcription of a voice message (column 13, lines 11-14).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use sending a text transcription of a voice message of Sekiguchi in the invention of Goldfinger and Vardi.

The modification of the invention would offer the capability of sending a text transcription of a voice message such as the system would allow a real-time message exchange.

Regarding **claim 28**, Goldfinger and Vardi as applied to **claim 22** differ from **claim 28,** in that it fails to disclose a portion of a voice messaging system.

However, Sekiguchi teaches the messaging module is a portion of a voice messaging system in the telephone network (7 on FIG. 1).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a portion of a voice messaging system of Sekiguchi in the invention of Goldfinger and Vardi.

The modification of the invention would offer the capability of a portion of a voice messaging system such as the system would allow a real-time message exchange.

Regarding **claim 30**, Goldfinger and Vardi as applied to **claim 22** differ from **claim 30,** in that it fails to disclose a portion of a voice messaging system.

However, Sekiguchi teaches the messaging module is a portion of a voice messaging system within a personal computer connected to the data network (2 on FIG. 1).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a portion of a voice messaging system of Sekiguchi in the invention of Goldfinger and Vardi.

The modification of the invention would offer the capability of a portion of a voice messaging system such as the system would allow a real-time message exchange.

Regarding **claim 31**, Goldfinger and Vardi as applied to **claim 22** differ from **claim 31,** in that it fails to disclose a portion of a voice messaging system.

However, Sekiguchi teaches the messaging module is a portion of a voice messaging system coupled to the telephone network (1 on FIG. 1).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a portion of a voice messaging system of Sekiguchi in the invention of Goldfinger and Vardi.

The modification of the invention would offer the capability of a portion of a voice messaging system such as the system would allow a real-time message exchange.

Response to Arguments

5. Applicant's arguments with respect to **claims 1-54** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

DeSimone is cited for an anonymous voice communication using on-line controls (FIG. 1).

Auerbach et al. is cited for a method for multi-protocol communication in a computer network (FIG. 1).

Long et al. is cited for a message communication system (FIG. 1).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

Gerald Gauthier
g.g.
May 1, 2003

Allan Hoosain
ALLAN HOOSAIN
PRIMARY EXAMINER for
Fan Tsang.